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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

49286US003

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on February 16, 2007

Signature

Typed or printed name James D. Withers

Application Number

08/421,055

Filed

April 12, 1995

First Named Inventor

Johnson et al.

Art Unit

1733

Examiner

Johnstone, A.C.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

(The Notice of Appeal was filed by JM on February 15, 2007.)

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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attorney or agent of record.

Registration number 40,376

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

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February 16, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Johnson)	Art Unit: 1733
)	
Serial No.: 08/421,055)	Examiner: Johnstone, A.
)	
Filing Date: April 12, 1995)	3M Matter No. : 49286US003

For: MELT-FLOWABLE MATERIALS AND METHOD OF SEALING SURFACES

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal review of the present application for at least the following reasons:

1. Japanese Patent Application No. 3-273975 (hereinafter, "JP'975") fails to anticipate previously presented claims 6, 8, 16-17, 19-24, and 34.

In order to establish anticipation, a prior art reference must disclose every feature of the claimed invention, see *Finnigan Corp. v. International Trade Commission*, 180 F.3d 1354, 1365, 51 USPQ2d 1001, 1009 (Fed. Cir. 1999).

As discussed in Applicant's August 14, 2006 Amendment and Response and in Applicant's February 16, 2007 Request For Reconsideration, JP'975 fails to disclose a method comprising heating a sheet material to a melt sealing temperature sufficient to (1) cause a melt-flowable composition of the sheet material to melt, flow and level out over surface imperfections or fill gaps in a step joint, while (2) a dimensionally stable film of the sheet material remains sufficiently dimensionally stable at the melt sealing temperature so as not to melt and flow or exhibit wrinkling. Consequently, JP'975 cannot anticipate independent claim 6 or claims 8, 16-17, 19-24, and 34, which depend from independent claim 6.

On page 2, lines 16-18 of the November 16, 2006 final Office Action, Examiner Johnstone argues that JP'975 discloses a baking step during which tape 4 (i.e., the entire tape, both upper layer 4a and lower layer 4b) "softens (but does not melt) during

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baking but hardens after cooling to ordinary temperature (translation p. 8).” Due to the disclosure of a “baking process” in JP’975, Examiner Johnstone concludes that JP’975 discloses the recited heating step of independent claim 6. Applicant disagrees.

There simply is no indication or suggestion in JP’975 that the baking step disclosed in JP’975 is a heating step as recited in independent claim 6, namely, a heating step in which the disclosed tape (i.e., tape 4) is heated to a baking temperature sufficient to cause (1) a portion of the disclosed tape to “melt, flow and level out over surface imperfections or fill gaps in a step joint,” while (2) another portion of the disclosed tape remains sufficiently dimensionally stable at the baking temperature so as “not to melt and flow or exhibit wrinkling.”

On page 3, lines 1-3 of the November 16, 2006 final Office Action, Examiner Johnstone appears to realize that the disclosure of JP’975 does indeed fail to disclose Applicant’s claimed method steps as recited in independent claim 6 by making an inherency argument, specifically stating:

Note that with respect to any inherent feature discussed above, the reasoning supplied in the discussion provides sufficient basis for the examiner to infer that the feature is inherent; burden is therefore shifted to applicants to show lack of inherency (see for example the case law cited in MPEP 2112-2112.02).

Applicant notes that the referenced case law specifically states that “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient. ’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). (Emphasis added.) Also, “[a]n invitation to investigate is not an inherent disclosure” where a prior art reference “discloses no more than a broad genus of potential applications of its discoveries.” *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1367, 71 USPQ2d 1081, 1091 (Fed. Cir. 2004) (explaining that “[a] prior art reference that discloses a genus still does not inherently disclose all species within that broad category” but must be examined to see if a disclosure of the claimed

species has been made or whether the prior art reference merely invites further experimentation to find the species.

Further, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter balloon. The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.).

Applicant respectfully submits that Examiner Johnstone has not provided any objective evidence or cogent technical reasoning to support the position that the broad description of a "baking process" in JP'975 is a heating step using a baking temperature that causes (1) a portion of the disclosed tape to "melt, flow and level out over surface imperfections or fill gaps in a step joint," while (2) another portion of the disclosed tape remains sufficiently dimensionally stable at the baking temperature "so as not to melt and flow or exhibit wrinkling" as required in Applicant's independent claim 6. Applicant respectfully submits that Examiner Johnstone has merely relied on the possibility that the disclosed tape and some possible baking temperature could behave in a manner as recited in Applicant's independent claim 6.

2. Examiner Johnstone has failed to make a *prima facie* case of obviousness in view of the teaching of JP'975 alone or in combination with any combination of U.S. Patent No. 4,822,683 to Schappert et al. (hereinafter, "Schappert"), U.S. Patent No. 4,920,182 to Manser et al. (hereinafter, "Manser"), U.S. Patent No. 4,877,679 to Leatherman et al. (hereinafter, "Leatherman1"), U.S. Patent No. 4,892,779 to Leatherman et al. (hereinafter, "Leatherman2"), Japanese Patent Application No. 58-217516 (hereinafter, "JP'516"), European Patent Application No. 0 384 598 A1

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(hereinafter, "EP'598"), and Japanese Patent Application No. 1-152049 A (hereinafter, "JP'049") when rejecting claims 6-13, 16-17-24, 26-29, and 31-37.

The teaching of JP'975 alone or in combination with any combination of the above-mentioned references fails to disclose, teach or suggest Applicant's method steps as recited in independent claims 6, 28 and 29. In particular, the teaching of JP'975 alone or in combination with any combination of the above-mentioned references fails to disclose, teach or suggest the following claim features of independent claims 6, 28 and 29:

(1) (a) placing a sheet material comprising (i) a lower melt-flowable layer comprising a melt-flowable composition, and (ii) a dimensionally stable film for controlling the melt-flow behavior of said melt-flowable composition, said film being sufficiently dimensionally stable so as not to melt and flow or exhibit wrinkling when heated to a melt sealing temperature of the melt-flowable composition and subsequently cooled; and (b) heating the sheet material to a melt sealing temperature sufficient to cause said melt-flowable composition to (1) melt, flow and level out over surface imperfections or fill gaps in the step joint, as well as (2) adhere and form a bond to the step joint (independent claim 6, 28 and 29);

(2) the above described method wherein the melt-flowable composition comprises a semi-crystalline, thermosetting epoxy-polyester blend and the dimensionally stable film comprises an oriented polyester film (independent claim 28); and

(3) the above described method wherein the dimensionally stable film comprises a substantially smooth, paint-receptive upper surface comprising a thermosetting epoxy-polyester blend (independent claim 29).

Examiner Johnstone argues that it would have been obvious to modify Applicant's claimed method and the components used therein simply because the components are "notoriously well-known." See, for example, beginning on page 3, line 22 of the November 16, 2006 final Office Action where Examiner Johnstone argues the substitution of a MYLAR film for the hot-melt layer 4a in the disclosed tape of JP'975 by stating:

As to claims 12 and 13, oriented polyethylene terephthalate film such as MYLAR is notoriously well known to have dimensional stability, therefore it would have been obvious to one of ordinary skill in the art to

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use such notoriously well known dimensionally stable oriented polyethylene terephthalate film as the hot-melt base film in the above method.

During a January 19, 2007 telephone interview, Applicant again noted that the art of record must at least teach or suggest the desirability of Examiner Johnstone's proposed modification of JP'975 as required in the case law. See, for example, the statement of the Court in *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

Given the lack of motivation and suggestion in the art of record to modify the teaching of JP'975, Applicant respectfully submits that Examiner Johnstone has failed to make a *prima facie* case of obviousness in view of the teaching of JP'975 alone or in combination with any combination of the above-mentioned references.

3. Examiner Johnstone has failed to make a *prima facie* case of obviousness in view of the teaching of JP'049 in combination with any combination of U.S. Patent No. 5,126,188 to Shimizu et al. (hereinafter, "Shimizu"), U.S. Patent No. 5,162,149 to Reaney (hereinafter, "Reaney"), Schappert, Manser, Leatherman1, Leatherman2, JP'516, JP'975, and EP'598 when rejecting claims 6-13, 16-24, 26-29, 31-35.

The teaching of JP'049 alone or in combination with any combination of the above-mentioned references fails to disclose, teach or suggest Applicant's method steps as recited in independent claims 6, 28 and 29 for the reasons similar to those given above in section (2).

4. Examiner Johnstone has failed to make a *prima facie* case of obviousness in view of the teaching of U.S. Patent No. 2,739,919 to Artzt (hereinafter, "Artzt") in combination with Manser and JP'516 when rejecting claims 29 and 31.

The teaching of Artzt in combination with the teachings of Manser and JP'516 fails to disclose, teach or suggest Applicant's method steps as recited in independent claim 29 for the reasons similar to those given above in section (2).

Attorney Docket No. 10002.0098US01